

**REMARKS**

Claims 44-82, 90, 91, 93-96, and 98-104 are pending in the application. By this Preliminary Amendment, claims 100-104 have been added.

This Preliminary Amendment is being filed with a Request for Continued Examination (RCE). This Preliminary Amendment addresses the Final Office Action dated September 17, 2002.

Claims 44, 63, 98, and 99 are rejected under 35 U.S.C. §102(e) by Stasiuk, U.S. Patent No. 6,105,806 (the Stasiuk patent). This rejection is respectfully traversed.

This rejection has been discussed in detail with Primary Examiner Gerrity and Examiner Huynh during a personal interview conducted on June 3, 2002 and subsequent telephone interviews. Moreover, this rejection has been thoroughly addressed in the Amendment of May 28, 2002 and the Supplemental Amendments of June 6, 2002 and July 8, 2002. The contents of these Amendments are incorporated herein by reference.

In summary, the Examiner asserts that Stasiuk discloses engraving into the metal of the tab. The Examiner specifically points to column 3, lines 15-20 and column 8, line 58-column 9, line 17 of Stasiuk to support this conclusion.

After review of the Stasiuk reference, Applicant believes that the Examiner's assertion is inaccurate. As aforesaid in our June 6, 2002 and July 8, 2002 Supplemental Amendments, Stasiuk does not laser engrave metal – it only teaches removal of a non-metal coating to expose the underlying metal (aluminum) layer. Stasiuk is entirely directed to the laser removal of a coating provided on the tab to merely expose the metal, and nowhere discusses that the laser engravings extends into a metal portion of the metal strip to form marks in at least one of the upper surface and the lower surface of the metal strip.

To further support this conclusion, Stasiuk filed a PCT application (copy enclosed with the Information Disclosure Statement filed herewith) on March 12, 2002, which has priority to a U.S. provisional Application dated March 13, 2000. This date is after the U.S. filing date of the subject application. The PCT application is directed to laser-etched pull tabs. Specifically, the PCT application discloses laser-etching indicia on a pull-tab substrate by selective laser ablation of the substrate with a laser marker.

Moreover, as discussed in the Summary of the Invention of the PCT Application, Applicant notes that:

In order to overcome the aforementioned deficiencies of the prior art, Applicant previously disclosed a method of providing coated tab stock in which decorative, promotional, or informative indicia is laser-etched thereon. For example, Applicant's previous applications: U.S. Serial No. 08/917,516,

filed August 26, 1997 [now abandoned] and U.S. Serial No. 09/061,227, filed April 17, 1998 [now U.S. Patent No. 6,105,806], which are hereby incorporated by reference in their entirety, teach laser-etching pull tabs in order to provide high definition, high clarity indicia thereon.

Applicant's previous applications highlighted Applicant's then preferred embodiments wherein pull tabs having one or more coating layers had portions of such layers selectively removed to form indicia on said pull tab. According to the invention a pull tab is provided having selective removal of not only the coating layer or layers, but also a portion of the substrate itself. According to Applicant's presently preferred method of laser engraving a coated pull tab, the substrate itself may be permanently etched with at least a portion of the intended indicia, thereby preventing counterfeit or easy disfiguration of the pull tab's indicia. Page 2, line 25 - page 3, line 10. (Emphasis added.)

This is incontrovertible evidence that the Stasiuk U.S. Patent was not concerned with laser engraving the metal of the tab.

Thus, Stasiuk does not disclose the method as recited in claim 44 and the apparatus as recited in claim 63. Withdrawal of the rejection of claims 44 and 63 is respectfully requested.

Claims 98 and 99 are allowable by virtue of their dependence on claims 63 and 44, respectively, and for their recitation of additional patentable subject matter. For example, Stasiuk does not disclose that the metal strip has a thickness defined between the upper surface and the lower surface, and the laser engravings extend into a metal portion of the metal strip to a depth that is within the thickness of the metal strip, as recited in claim 98.

Also, new claims 100, 103, and 104 have been added. Stasiuk does not disclose extending the laser engravings a finite depth into a metal portion of the metal strip to form marks in at least one of the upper surface and the lower surface of the metal strip, as recited in claim 100. Moreover, Stasiuk does not disclose laser engravings that form marks into the metal surface of the strip, as recited in claim 103. New claim 104 depends from claim 103 and recites extending the laser engravings through a coating provided on the metal strip and into the metal surface of the strip. Allowance of these new claims is respectfully requested.

Claims 44, 45, 56, 57, 61-64, 74-76, 81, 82, 90, 91, 93-96, 98, and 99 are rejected under 35 U.S.C. §103(a) over Kubacki et al., U.S. Patent No. 4,476,781, in view of Stasiuk. Claims 46-49 and 65-67 are rejected under 35 U.S.C. §103(a) over Kubacki et al. in view of Stasiuk as applied to claims 44 and 63 above and further in view of Kwon, U.S. Patent No. 6,160,835. Claims 50-55 and 68-73 are rejected under 35 U.S.C. §103(a) over Kubacki et al. in view of Stasiuk further in view of Kwon as applied to claims 46 and 65 above, and further in view of Kobsa, U.S. Patent No. 6,163,010. Claims 58-60 and 77-79 are rejected under 35

U.S.C. §103(a) over Kubacki et al in view of Stasiuk as applied to claims 44 and 76 above and further in view of JP 7-53099. These rejections are respectfully traversed.

Neither Kubacki, Kwon, Kobsa, nor JP 7-53099 make up for the deficiencies noted above with respect to Stasiuk. Therefore, independent claims 44, 63, 90, 91, 93, 95 are allowable for at least the reasons noted above with respect to Stasiuk and the remaining dependent claims are allowable by virtue of their dependence on these independent claims and for their recitation of additional patentable subject matter.

Claims 44, 45, 56-57, 61-64, 74-76, 81, 82, 89-96, and 98 are rejected under 35 U.S.C. §103(a) over Kubacki et al in view of Carlson, U.S. Patent No. 4,375,025. This rejection is respectfully traversed.

This rejection was discussed in detail with Primary Examiner Gerrity and Examiner Huynh during a personal interview conducted on June 3, 2002 and subsequent telephone interviews. However, the current Office Action simply reiterates comments from the Office Action dated December 28, 2001 and does not address Applicant's comments from the May, 28, 2002 Amendment and the Supplemental Amendments of June 6, 2002 and July 8, 2002. Applicant believes that this rejection has been overcome and the inclusion of this rejection in the current Office Action was done in error.

In any event, Applicant will reiterate remarks that are provided in the Preliminary Amendment dated December 5, 2001, the Amendment dated May 28, 2002, and the Supplemental Amendment filed June 6, 2002 for the Examiners' convenience.

In previous responses, Applicant's undersigned representative noted that Kubacki and Carlson are directed to non-analogous arts because 1) they are not from the same field of endeavor, and 2) they are not directed to solving the problems that are solved by the present Applicant. Applicant's concern was with providing a laser for metal in an environment where the material is fed intermittently. By sharp contrast, Carlson is directed to laser marking electrical components that are continuously moved past a laser source. Carlson is not concerned with providing laser engraved marks on a work piece when the work piece is in an immobilized condition. Moreover, Carlson is not concerned with laser engraving an opening tab for beverage cans. Also, Kubacki does not disclose the use of a laser for engraving, and was not aware of the problems associated with laser engraving for an intermittently fed strip. Applicant discovered how to apply a laser to an intermittently fed strip used to make beverage cans. See page 3, line 26 to page 4, line 29, and page 8, lines 6 to 32.

Accordingly, the laser system of Carlson cannot be modified to provide laser engraving for an intermittently fed strip without the benefit of Applicant's disclosure and impermissible hindsight. See Grain Processing Corp. v American Maize-Products Co., 840 F.2d 902, 907, 5 USPQ2d 1788, 1792 (Fed. Cir. 1988) ("It is impermissible to use the applicant's disclosure as a blueprint to reconstruct the claimed invention out of isolated teachings in the prior art"). Moreover, there is no motivation for "picking" and "choosing" among the various elements of Kubacki/Carlson, to the exclusion of other elements, to arrive at the claimed combination. See In re Kamm, 172 USPQ 298, 301, 302 (CCPA 1972) ("It is impermissible within the framework of section 103 to pick and choose from any one reference only so much of it as will support a given position, to the exclusion of other parts necessary to the full appreciation of what such reference fairly suggests to one of ordinary skill in the art").

Thus, neither Kubacki nor Carlson teach or suggest a method that includes providing at least one of the upper surface and the lower surface of a metal strip with laser engravings from a laser unit when the strip is in an immobilized condition, as recited in claim 44. Further, neither Kubacki nor Carlson teach or suggest an apparatus that includes a control unit that controls the laser unit so that laser engravings are provided on at least one of the upper surface and the lower surface of a metal strip when the strip is in an immobilized condition between periods of intermittent movement, as recited in claim 63. Further, neither Kubacki nor Carlson teach or suggest an apparatus that includes a control unit that controls the laser unit so that laser engravings are provided on at least one of the upper surface and the lower surface of a metal strip when the strip is between periods of rapid movement, as recited in claim 90. Further, neither Kubacki nor Carlson teach or suggest a method that includes providing at least one of the upper surface and the lower surface of a metal strip with laser engravings from a laser unit when the strip is in between periods of rapid movement, as recited in claim 91. Further, neither Kubacki nor Carlson teach or suggest a method that includes forming laser engraved marks with a laser unit on at least a selected surface of the upper surface and the lower surface of a metal strip when the strip is in an immobilized condition, as recited in claim 93. Further, neither Kubacki nor Carlson teach or suggest an apparatus that includes a control unit that controls the laser unit so that laser engraved marks are provided on at least a selected surface of the upper surface and the lower surface of a metal strip when the strip is an immobilized condition, as recited in claim 95.

Withdrawal of this rejection of independent claims 44, 63, 90, 91, 93, and 95 is respectfully requested. The remaining dependent claims are allowable by virtue of their

dependence on these independent claims and for their recitation of additional patentable subject matter.

Claims 46 and 65 are rejected under 35 U.S.C. §103(a) over Kubacki et al in view of Carlson as applied to claims 44 and 63 above and further in view of Kwon. Claims 47-55 and 66-73 are rejected under 35 U.S.C. §103(a) over Kubacki et al in view of Carlson, further in view of Kwon as applied to claims 46 and 65 above and further in view of Kobsa. Claims 58-60 and 77-79 are rejected under 35 U.S.C. §103(a) over Kubacki et al in view of Carlson as applied to claims 44 and 76 above and further in view of JP 7-53099. These rejections are respectfully traversed.

Neither Kwon, Kobsa, nor JP 7-53099 make up for the deficiencies noted above with respect to Kubacki and Carlson. Therefore, these dependent claims are allowable by virtue of their dependence on claims 44 and 63, and for their recitation of additional patentable subject matter.

Also, claim 99 is objected to under 37 CFR 1.75(c). This rejection is respectfully traversed.

Claim 99 is a product by process claim and should not be rejected as being improper. Please see MPEP 2173.05(f), MPEP 2173.05(p), and MPEP 608.01(n)(III.). Withdrawal of this objection is respectfully requested.

New claims 100-104 have been added. Claims 100, 103, and 104 are allowable for reasons discussed above with respect to Stasiuk. Claims 101 and 102 are allowable by virtue of their respective dependencies on claims 44 and 63 and for their recitation of additional patentable subject matter.

Moreover, should the new claims initiate a new grounds for rejection, the first Office Action cannot be a Final Office Action.

Should the Examiner believe that anything further is desirable to place the application in better condition for allowance, he is invited to contact the undersigned at the telephone number listed below.

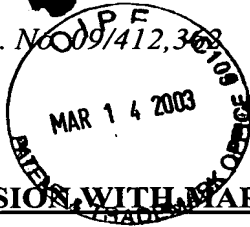
Respectfully submitted,  
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APPENDIX

VERSION WITH MARKINGS TO SHOW CHANGES MADE

IN THE CLAIMS:

New claims 100-104 have been added.

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